

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q83107

Nicolas DREVON

Appln. No.: 10/509,852

Group Art Unit: 2617

Confirmation No.: 4310

Examiner: Celeste LOFTIN

Filed: September 30, 2004

For: **METHOD FOR CONTROLLING ACCESS RIGHTS IN A CELLULAR MOBILE
RADIO COMMUNICATION SYSTEM**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

Based on information supplied by the Appellant and to the best knowledge of the Appellant's legal representatives, the real party in interest is the assignee, Alcatel, by virtue of an Assignment executed on September 1, 2004, and recorded on October 27, 2005, at Reel 016693, Frame 0079.

II. RELATED APPEALS AND INTERFERENCES

To the best of their knowledge, there are no other related appeals or interferences known to Appellant, Appellant's legal representatives or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1-16 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. All the claims pending in the present application have been set forth in their entirety in the attached Appendix.

IV. STATUS OF AMENDMENTS

There are no outstanding, non-entered amendments of the claims in the instant application.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a method for controlling access rights in a cellular mobile radio system, the method comprising transferring roaming agreement information from a core network to a radio access network of said cellular mobile radio system, wherein said roaming agreement information is transferred independently of messages linked to calls or user equipments. *See e.g.*, Specification, paragraph bridging pages 10 and 11, first full paragraph on page 15 and FIG. 3.

Independent claim 11 is directed to a radio access network equipment of a cellular mobile radio system, the radio access network equipment comprising means for receiving roaming agreement information from a core network equipment, wherein the roaming agreement information is received independently of messages linked to calls or user equipments. *See e.g.*, Specification, first full paragraph on page 15, first full paragraph on page 18 and FIG. 3, element RNC13.

Independent claim 13 is directed to a core network equipment of a cellular mobile radio system, the core network equipment comprising means for transferring roaming agreement information to a radio access network equipment, wherein the roaming agreement information is transferred independently of messages linked to calls or user equipments. *See e.g.*, Specification, first full paragraph on page 15, first full paragraph on page 18 and e.g., FIG. 3, element VLR12.

Independent claim 16 is directed to a mobile radio system comprising a plurality of mobile terminals; a core network which contains roaming agreement information; and a radio access network which communicates with the mobile terminals and the core network and

manages mobility of the mobile terminals within the radio access network wherein the roaming agreement information is transferred independently of messages linked to calls or user equipments. *See e.g.*, Specification, page 14, line 13 through page 15, line 9, first full paragraph on page 18, and FIG. 3.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A). Rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

VII. ARGUMENT

(A). Rejection of Claims 1-16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement

Each of the independent claims 1, 11, 13 and 16 recites, *inter alia*, “wherein said roaming agreement information is transferred independently of messages linked to calls or user equipments.”

The Examiner asserts that since the Specification states that the roaming agreement is common to a subset of ISMI, the roaming agreement still provides a link to user equipment. Appellant respectfully disagrees with the Examiner’s position.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. *See* MPEP § 2164.01. “The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *See United States v. Telecommunications, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). Any part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein. *Callicrate v.*

Wadsworth Mfg., Inc., 427 F.3d 1361, 77 USPQ2d 1041 (Fed. Cir. 2005) (discussion of problems with a prior art feature does not mean that one of ordinary skill in the art would not know how to make and use this feature).

The Specification states:

One aspect of the invention proposes that access rights information that corresponds to semistatic information, such as roaming agreement information in particular, be transferred independently of the management of radio access bearers at the interface between the core network and the radio access network, or in other words that this information not be linked to a particular user.

Thus, as noted above, the cited portion of the Specification states that semistatic information corresponds to roaming agreement information.

Further, Appellant respectfully submits that page 18, lines 32-33 of the Specification fully provides the enabling support pertaining to the claimed features. *See e.g.*, Specification, page 18, lines 20-33, “semistatic information is no longer transferred via messages linked to calls or to UEs.” In other words, the above-noted portions of the Specification state that the semistatic information, i.e., the roaming agreement information, is transferred independently of the management of radio access bearers at the interface between the core network and the radio access network, or in other words that this information not be linked to a particular user.

Additionally, Appellant submits that the noted features of the claims are plainly in line with the descriptions found in the Specification. That is, while the Specification describes that the “[a]ccess rights are usually controlled on the basis of user identification data, such as an

international mobile subscriber identity (IMSI) number,” the Specification is also *unambiguous* in stating that the claimed “roaming agreement” is “generally not available in the terminal or in the radio access network, but is generally centralized in a routing agreement database, for example of the visitor location register (VLR) type, provided in the *core network*[.]” *See* Specification, page 4, lines 25-27 and page 5, lines 7-15 (*emphasis added*). As the claimed “roaming agreement” is stored in the core network and not in the “radio access network” nor in the “user equipments,” the claims recite such transfer of the “roaming agreement” from the core network to the “radio access network” and the “user equipments.”

Appellant respectfully submits that the portion of the Specification cited by the Examiner is in plain support of the above-mentioned disclosure found in the remainder of the Specification. *See e.g.*, Specification, page 10, line 25 to page 11, line 10. In other words, while the cited portion of the Specification describes that the roaming agreement information may be “common to a subset of the international mobile subscriber identity (IMSI) number,” such disclosure does not negate the fundamental fact that the roaming agreement must be initially imported from the core network, regardless of the use of IMSI information in any particular call. *See e.g.*, Specification, page 8, lines 3-5 and page 11, first full paragraph. Besides, the cited portion of the Specification relates to transferred roaming agreement information itself, while the claims relate to a way of transferring roaming agreement information.

Furthermore, as noted above, the Specification provides that roaming agreement information, common to a subset of IMSI numbers, can be located in a VLR within the core network, and roaming agreement information relating to these users can be transmitted from the

core network to the radio access network, *independently* of any transaction related to a particular call or user equipment.

Consequently, Appellant submits that one reasonably skilled in the art could, for example, implement the claimed invention by simply transferring roaming agreement information from a core network to a radio access network independently of messages linked to calls or user equipments, just as set forth in the independent claims.

For example, as noted above, the independent claims 1, 11, 13 and 16 recite, *inter alia*, “wherein said roaming agreement information is transferred independently of *messages linked to calls or user equipments*” (*emphasis added*). In other words, the roaming agreement information is simply transferred from the core network to the radio access network without requiring messages specific to any particular user equipment or to any particular call.

Additionally, since the roaming agreement information is stored in the core network and may be common to a subset of the IMSI number, the roaming information is stored independently of and without regard to any particular IMSI number linked to a transaction relating to a particular call or user equipment. As such, the roaming agreement information can simply be transferred without regard to any particular IMSI number linked to a particular call or user equipment. Therefore, the claimed “roaming agreement information” can easily be transferred *independent* of any transaction relating to a particular call or user equipment. As a result, Appellant submits such an implementation would not require any undue experimentation, since the information is readily available in the core network, irrespective of the existence of any transaction relating to a particular call or user equipment.

In view of the above, Appellant submits that the Specification fully provides the enabling support pertaining to the claimed features "wherein said roaming agreement information is transferred independently of messages linked to calls or user equipments," such that one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

The fee required under 37 C.F.R. §41.37(a) and 1.17(c), is being charged to Deposit Account No. 19-4880 via EFS Payment Screen.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Christopher R. Lipp
Registration No. 41,157

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: May 29, 2007

CLAIMS APPENDIX

CLAIMS 1-16 ON APPEAL:

1. A method for controlling access rights in a cellular mobile radio system, comprising transferring roaming agreement information from a core network to a radio access network of said cellular mobile radio system, wherein said roaming agreement information is transferred independently of messages linked to calls or user equipments.

2. The method according to claim 1, wherein the roaming agreement information transferred is common to a public land mobile network (PLMN) identified by a subset of an international mobile subscriber identity (IMSI) number.

3. The method according to claim 2, wherein said subset includes a mobile country code field (MCC) and a mobile network code (MNC) field.

4. The method according to claim 1, wherein according to said roaming agreement information access to a visited public land mobile network (VPLMN) is authorized for the whole VPLMN or limited to certain areas of said VPLMN.

5. The method according to claim 4, wherein said certain areas of said VPLMN are areas in which a home public land mobile network (HPLMN) does not provide radio coverage.

6. The method according to claim 1, wherein the roaming agreement information transferred is indicated for each location area (LA).

7. The method according to claim 1, wherein said roaming agreement information is transferred in the event of modification of said information in the core network.

8. The method according to claim 1, wherein the core network is configured beforehand with said roaming agreement information.

9. The method according to claim 8, wherein said configuration is effected by operation and maintenance means.

10. The method according to claim 1, wherein said roaming agreement information is stored in the core network in a database of a visitor location register (VLR) type.

11. A radio access network equipment of a cellular mobile radio system, the radio

access network equipment comprising:

means for receiving roaming agreement information from a core network equipment, wherein the roaming agreement information is received independently of messages linked to calls or user equipment.

12. The radio access network equipment according to claim 11, wherein the radio access network equipment is a radio network controller (RNC).

13. A core network equipment of a cellular mobile radio system, the core network equipment comprising:

means for transferring roaming agreement information to a radio access network equipment,

wherein the roaming agreement information is transferred independently of messages linked to calls or user equipment.

14. The core network equipment according to claim 13, wherein, said roaming agreement information is stored in a visitor location register (VLR), and said core network equipment takes a form of a mobile switching center (MSC) type equipment connected to a visitor location register (VLR).

15. The core network equipment according to claim 14, wherein, said roaming agreement information is stored in a visitor location register (VLR), and said core network equipment takes a form of a Serving General Packet Radio Service (GPRS) support node (SGSN) type equipment which integrates a visitor location register (VLR).

16. A mobile radio system comprising:

 a plurality of mobile terminals;

 a core network which contains roaming agreement information; and

 a radio access network which communicates with the mobile terminals and the core network and manages mobility of the mobile terminals within the radio access network wherein the roaming agreement information is transferred independently of messages linked to calls or user equipment.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
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EVIDENCE APPENDIX:

There has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other similar evidence.

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

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SUBMISSION OF APPEAL BRIEF

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Sir:

Submitted herewith please find an Appeal Brief. The statutory fee of \$500.00 is being charged to Deposit Account No. 19-4880 via EFS Payment Screen. The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Christopher R. Lipp
Registration No. 41,157

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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